

## REMARKS

The following remarks are submitted to address the above amendments and issues raised in the Official Action mailed March 3, 2006. Because June 3, 2006, falls on a weekend, the period for responding to this Official Action expires on June 5, 2006.

Upon entry of the foregoing amendments, claims 1-9, 11-12, 14-16, 18-24, 26-29, and 31 are now pending in this application. Claims 20-22 stand allowed. Claims 10, 13, 25, and 30 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claims 1-3, 6, 11-13 15, 16, 18, 19, 23, and 26-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,983,529 to Serna. Claims 1-4, 6-13, 15, 16, 18, 19, and 23-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,369,896 to Frachey.. Claims 4, 5, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Serna or Frachey. Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Serna or Frachey in view of U.S. Patent App. 2003/0084595 to Weiss.

No new matter has been added. Support for requested amendments can be found in the original claims and throughout the present specification and drawings. Applicant respectfully requests consideration of the application in light of the above amendments and the following remarks.

### Claims 10, 13, 25, and 30 – 35 U.S.C. § 112

The rejections of claims 10, 13, 25, and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention are respectfully traversed.

The Official Action states that in claims 10, 25, and 30, the phrase “same as the combined thicknesses of the insole cut out . . .” contradicts the limitation of substantially the same thickness of the midsole cut-out which is present in the independent claims from which these claims depend, rendering the claims vague and indefinite. The Official Action states that claim 13 is confusing, vague, and indefinite because it appears to merely recite an intended use and does not provide any additional structural limitations. (Official Action, p. 2.)

Claims 10, 13, 25, and 30 have been canceled herein. Therefore, Applicant respectfully submits that the rejections of claims 10, 13, 25, and 30 under 35 U.S.C. § 112, second paragraph, are now moot.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 10, 13, 25, and 30 under 35 U.S.C. § 112, second paragraph.

**Claims 1-3, 6, 11-13, 15, 16, 18, 19, 23, and 26-28 — 35 U.S.C. § 102(b)**

The rejections of claims 1-3, 6, 11-13, 15, 16, 18, 19, 23, and 26-28 under 35 U.S.C. § 102(b) as being anticipated by Serna are respectfully traversed.

Claim 1 of the present invention, as amended, claims “[a]n article of footwear, comprising: a midsole having a cut-out formed in the midsole, the cut-out having a shape and a thickness; a *removable display element having substantially the same shape and thickness as the midsole cut-out* so as to be fittingly insertable into the midsole cut-out; and an outsole having a transparent portion overlying the midsole cut-out; wherein when the display element is inserted into the midsole cut-out, the display element is viewable through the transparent portion of the outsole.” (Claim 1, emphasis added.)

Claim 23 of the present invention, as amended, claims “[a]n article of footwear, comprising: a midsole made of an opaque material and having a cut-out formed in the midsole, the cut-out having a shape and a thickness; a plurality of *removable interchangeable display elements*, each of the display elements *having a desired color and substantially the same shape and thickness as the midsole cut-out* so as to be fittingly insertable into the midsole cut-out; an outsole having a bottom and a transparent portion overlying the midsole cut-out; and an upper attached to the midsole and outsole and defining a volume for enclosing a wearer's foot; wherein the midsole and the display element comprise a resiliently compressible material, and wherein when the display element is inserted into the midsole cut-out, the display element is viewable through the transparent portion in the bottom of the outsole.” (Claim 23, emphasis added.)

Claim 26 of the present invention, as amended, claims “[a] method of making an article of footwear, comprising: forming a cut-out in a midsole of the footwear, the cut-out having a

shape and a thickness; providing a *removable display element having substantially the same shape and thickness as the midsole cut-out* for fittingly inserting into the midsole cut-out; forming a portion of an outsole of the footwear overlying the midsole cut-out from a transparent material; and inserting the display element into the midsole cut-out so that the display element is viewable through the transparent portion of the outsole.” (Claim 26, emphasis added.)

The Official Action states that Serna discloses a shoe and an inherent method of making a shoe comprising a midsole with a cut-out, a display element, an outsole, and a transparent portion. The Official Action states that the display element inherently has a color. (Official Action, para. 3.)

Serna discloses a shoe sole shock absorbing system that includes a shock absorbing cassette for the midsole. The shock absorbing cassette fits into a heel pocket in the midsole shaped to receive the shock absorbing cassette. The shock absorbing cassette and outsole may be bonded together by gluing or molding. A translucent window may also be provided in the heel area so that a consumer may view the cassette when purchasing the shoe.” (Serna, col. 2, lines 24-26; col. 4, lines 30-32; and col. 7, lines 44-46.)

Nowhere does Serna disclose a *removable display element having substantially the same shape and thickness as the midsole cut-out*, as in claims 1, 23, and 26 of the present application. In contrast, Serna discloses a shock absorbing cassette that is *bonded* to the midsole, toe guard, and outsole. The cushioning elements have a wide base (and a narrow tip) such that the heel pocket conforms to the edges of the wide base of the cushioning elements to improve bonding of the cassette to the midsole. (Serna, col. 2, lines 37-42; col. 4, lines 30-32; and col. 7, lines 55-59.) Rather than disclose a display element that is removable, Serna thus discloses that the shock absorbing cassette is *bonded* to the shoe. Likewise, Serna discloses nothing regarding *thickness* of the cassette but does disclose that the cassette dimensions vary from those of the heel pocket (at least at the narrow tip), and thus fails to disclose a display element having substantially the same thickness as a midsole cut-out. With respect to claim 23, Serna fails to disclose a *plurality* of removable interchangeable display elements. Therefore, Serna fails to disclose each and every element of claims 1, 23, and 26, and thus fails to anticipate these claims.

Claims 2-3, 6, 11-13, 15, 16, 18, 19, and 27-28 depend from either claims 1, 23, or 26. Accordingly, these dependent claims are likewise not anticipated by Serna.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 1-3, 6, 11-12, 15, 16, 18, 19, 23, and 26-28 under 35 U.S.C. § 102(b).

**Claims 1-4, 6-13, 15, 16, 18, 19, and 23-30 — 35 U.S.C. § 102(b)**

The rejections of claims 1-4, 6-13, 15, 16, 18, 19, and 23-30 under 35 U.S.C. § 102(b) as being anticipated by Frachey are respectfully traversed.

Claim 1 of the present invention, as amended, claims “[a]n article of footwear, comprising: a midsole having a cut-out formed in the midsole, the cut-out having a shape and a thickness; a *removable display element having substantially the same shape and thickness as the midsole cut-out* so as to be fittingly insertable into the midsole cut-out; and an outsole having a transparent portion overlying the midsole cut-out; wherein when the display element is inserted into the midsole cut-out, the display element is viewable through the transparent portion of the outsole.” (Claim 1, emphasis added.)

Claim 23 of the present invention, as amended, claims “[a]n article of footwear, comprising: a midsole made of an opaque material and having a cut-out formed in the midsole, the cut-out having a shape and a thickness; a plurality of *removable interchangeable display elements*, each of the display elements *having a desired color and substantially the same shape and thickness as the midsole cut-out* so as to be fittingly insertable into the midsole cut-out; an outsole having a bottom and a transparent portion overlying the midsole cut-out; and an upper attached to the midsole and outsole and defining a volume for enclosing a wearer's foot; wherein the midsole and the display element comprise a resiliently compressible material, and wherein when the display element is inserted into the midsole cut-out, the display element is viewable through the transparent portion in the bottom of the outsole.” (Claim 23, emphasis added.)

Claim 26 of the present invention, as amended, claims “[a] method of making an article of footwear, comprising: forming a cut-out in a midsole of the footwear, the cut-out having a shape and a thickness; providing a *removable display element having substantially the same*

shape and *thickness as the midsole cut-out* for fittingly inserting into the midsole cut-out; forming a portion of an outsole of the footwear overlying the midsole cut-out from a transparent material; and inserting the display element into the midsole cut-out so that the display element is viewable through the transparent portion of the outsole.” (Claim 26, emphasis added.)

The Official Action states that Frachey discloses a shoe and inherent method of making a shoe comprising a midsole with a cut-out, a display element, an insole with a cut-out, an outsole, and a transparent portion. The Official Action states that the display element inherently has a color. (Official Action, para. 4.)

Frachey discloses a sports shoe comprising a wedge fixed to a sole. The wedge includes a seat in which an insert comprising elastically deformable elements is positioned. The sole comprises a reinforcement element below the insert, which may be formed of a somewhat transparent material. (Frachey, col. 2, lines 38-65 and col. 3, lines 49-52.)

Nowhere does Frachey disclose a *removable display element having substantially the same shape and thickness as the midsole cut-out*, as in claims 1, 23, and 26 of the present application. In contrast, Frachey discloses an insert (13) mounted in a seat (16) in a wedge (3) through a mounting insole (5) and *secured* by a projection (22) extending downward from a further insole (6). Thus, Frachey discloses an insert having a thickness sufficient to extend above the wedge (3) through one insole (5) and into a second insole (6). Accordingly, Frachey fails to disclose a display element that is either removable or that is *substantially the same thickness as the midsole cut-out*. With respect to claim 23, Serna fails to disclose a *plurality* of removable interchangeable display elements. Therefore, Serna fails to disclose each and every element of claims 1, 23, and 26, and thus fails to anticipate these claims.

Claims 2-4, 6-13, 15, 16, 18, 19, 24-25, and 27-30 depend from either claims 1, 23, or 26. Accordingly, these dependent claims are likewise not anticipated by Serna.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 1-4, 6-9, 11-12, 15, 16, 18, 19, and 23-24, and 26-29 under 35 U.S.C. § 102(b).

**Claims 4, 5, and 17 — 35 U.S.C. § 103(a)**

The rejections of claims 4, 5, and 17 under 35 U.S.C. § 103(a) as being unpatentable over either Serna or Frachey are respectfully traversed. Claim 17 has been canceled herein.

Claim 1 of the present invention, as amended, claims “[a]n article of footwear, comprising: a midsole having a cut-out formed in the midsole, the cut-out having a shape and a thickness; a *removable display element having substantially the same shape and thickness as the midsole cut-out* so as to be fittingly insertable into the midsole cut-out; and an outsole having a transparent portion overlying the midsole cut-out; wherein when the display element is inserted into the midsole cut-out, the display element is viewable through the transparent portion of the outsole.” (Claim 1, emphasis added.)

The Official Action states that Serna or Frachey shows a shoe substantially as claimed except for the exact shape of the insert. The Official Action states that the use of oval as a shape is considered to be an obvious choice of design, that the use of a circular or oval shape for heel cushions is well known and conventional in the art of footwear, and that it would have been obvious to make the heel inserts circular or oval in the footwear of either Serna or Frachey to make the footwear easier, faster, and cheaper to manufacture. The Official Action states that in reference to claim 17, the use of gel pads for heel cushions is well known and conventional in the art of footwear, and that it would have been obvious to replace the heel cushion inserts of either Serna or Frachey with a gel-filled insert to provide the user with a specific desired cushioning. (Official Action, para. 6.)

As discussed herein, both Serna and Frachey fail to disclose a *removable display element having substantially the same shape and thickness as the midsole cut-out*, as in claim 1 of the present application. Accordingly, both Serna and Frachey fail to disclose each and every element of claim 1, and thus each fails as a reference with respect to claim 1. Neither Serna nor Frachey provide any suggestion or motivation to apply a circular or oval shape to an article of footwear having a removable display element having substantially the same shape and thickness as the midsole cut-out. Moreover, neither claim 1, nor claims 4 or 5, claim a *heel cushion*, as suggested in the Official Action. Claims 4 and 5 depend from claim 1. Therefore, Applicant

respectfully submits that claims 4 and 5 would not have been obvious to one of ordinary skill in the art at the time the invention was made.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 4 and 5 under 35 U.S.C. § 103(a).

**Claim 14 — 35 U.S.C. § 103(a)**

The rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Serna or Frachey in view of Weiss is respectfully traversed.

Claim 1 of the present invention, as amended, claims “[a]n article of footwear, comprising: a midsole having a cut-out formed in the midsole, the cut-out having a shape and a thickness; a *removable display element having substantially the same shape and thickness as the midsole cut-out* so as to be fittingly insertable into the midsole cut-out; and an outsole having a transparent portion overlying the midsole cut-out; wherein when the display element is inserted into the midsole cut-out, the display element is viewable through the transparent portion of the outsole.” (Claim 1, emphasis added.)

The Official Action states that Serna or Frachey shows a shoe substantially as claimed except for providing logo indicia on the insert, that Weiss teaches providing logo indicia on the bottom viewable portion of an insert, and that it would have been obvious to provide logo indicia as taught by Weiss in the shoe of either Serna or Frachey to provide viewable indicia for amusement, sales, etc. (Official Action, para. 7.)

Weiss discloses a shoe having window communicating from the interior surface to the exterior surface of the shoe, such as in the heel of the shoe. A removable member can comprise an indicia-bearing member bonded to an insole. When the insole and indicia-bearing member are installed in the shoe, the indicia-bearing member intrudes into the heel interior volume, which serves to locate the indicia with respect to the window so that the indicia are displayed to an observer through the window. (Weiss, paras. 6 and 15-20.)

As discussed herein, both Serna and Frachey fail to disclose a *removable display element having substantially the same shape and thickness as the midsole cut-out*, as in claim 1 of the

present application. Accordingly, both Serna and Frachey fail to disclose each and every element of claim 1, and thus each fails as a reference with respect to claim 1. Weiss fails to correct the deficiencies of both Serna and Frachey as references. In addition, neither Serna, Frachey, or Weiss provide any suggestion or motivation to provide a removable display element *having substantially the same shape and thickness as the midsole cut-out* comprising logo indicia. Claim 14 depends from claim 1. Therefore, Applicant respectfully submits that claim 14 would not have been obvious to one of ordinary skill in the art at the time the invention was made.

For all of these reasons, the Office is respectfully requested to withdraw the rejection of claim 14 under 35 U.S.C. § 103(a).

**Allowed Claims**

The Official Action states that claims 20-22 are allowed.

**New Claim – Claim 31**

In view of the cancellation of claim 10, new claim 31 has been added herein to further clarify the subject matter of the present invention.

**CONCLUSION**

Applicant submits that a full and complete response has been made herein to the Official Action and, as such, all pending claims in this application are now in condition for allowance. Therefore, Applicant respectfully requests early consideration of the present application, entry of all amendments herein requested, withdrawal of all rejections, and allowance of all pending claims.

The Office is respectfully invited to contact J. Michael Boggs at (336) 747-7536, to discuss any matter relating to this application.

Respectfully submitted,

6/5/06  
Date

J. Michael Boggs  
J. Michael Boggs  
Reg. No. 46,563

Kilpatrick Stockton LLP  
1001 West Fourth Street  
Winston-Salem, NC 27101  
(336) 747-7536  
(336) 734-2632 (facsimile)

41872-298797  
9329724.1